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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/206,249      | 12/07/1998  | MIRI SEIBERG         | JBP438              | 5255             |

7590 10/25/2004

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| EXAMINER |
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MELLER, MICHAEL V

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| ART UNIT | PAPER NUMBER |
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1654

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/206,249

Applicant(s)

SEIBERG ET AL.

Examiner

Michael V. Meller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24,28-36,38,40,44-47 and 58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24,28-36,38,40,44-47 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

The election of species of record is maintained for the reasons of record.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

Claims 24, 28-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Limtrakul et al.

Applicant argues that Limtrakul does not apply the same composition as applicants because applicant argues that the soybean milk of Limtrakul must have had the STI inactivated because otherwise it would not have been suitable for the mouse to ingest.

Nowhere in Limtrakul do they say that the STI in the soybean milk was inactivated. Thus, the same composition as applicants was given to the mice in Limtrakul.

Further, it is known that tofu contains soybeans. Tofu is eaten by humans as a food source. Thus, if tofu can be eaten by a human so can soybean milk.

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Thus, the reference clearly teaches administration of the composition to a mammalian cell.

Claims 24, 28-36, 38, 40, 44-47 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Kosaka.

Applicant argues that Kosaka teaches use of papain and citric acid. While this may be true, Kosaka also teaches administering soybean milk. Applicant argues that citric acid is not required by the claims, but the claims do not exclude citric acid so applicant is incorrect in their statement. The claims do read on using citric acid. Applicant's claims have not excluded the use of citric acid.

Further, it is known that tofu contains soybeans. Tofu is eaten by humans as a food source. Thus, if tofu can be eaten by a human so can soybean milk.

Claims 24, 28-36, 38, 40, 44-47 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 62036304 (applicant notes this reference as Katsumi).

JP teaches a composition containing soybean milk which is applied to the skin. The translation of JP makes it clear that water can be added to the soybean milk and applied to the forehead, arms or hands.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application

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being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 24, 28-36, 38, 40, 44-47 and 58 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/110,409 which has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application.

Applicant's comments concerning this rejection are not well taken. Applicant even admits that the inventive entities are one and the same as the instant application and that of 09/110,409. Thus, it is not understood what applicant is arguing.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

***Claim Rejections - 35 USC § 103***

Claims 24, 28-36, 38, 40, 44-47, 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Limtrakul et al. taken with Kosaka or JP 62036304.

The above discussions also apply to this rejection.

### ***Double Patenting***

Claims 24, 28-36, 38, 40, 44-47 and 58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of U.S. Patent No. 09/110,409. Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims have not in fact been patented.

Without the terminal disclaimer, this rejection is maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael V. Meller  
Primary Examiner  
Art Unit 1654

MVM